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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/934,178

08/21/2001

Brian J. Brown

S63.2N-5605-US05

8077

490 7590 07/13/2007  
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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

07/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/934,178	BROWN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Paul B. Prebilic	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9, 10 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al (US 5,935,161). Robinson anticipates the claim language where the peaks as claimed are the pointed ends of the portions of the segments (33 and 35) that extend past the graft in Robinson; see Figure 3.

With regard to claim 19, Applicant is directed to column 8, line 38 to column 9, line 32 that clearly demonstrates that the anchors have self-expanding properties.

Claims 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinchasik et al (US 5,449,373). Pinchasik anticipates the claim language where the peaks of adjacent ends of the cell are clearly offset; see Figures 2A to 2C.

With regard to claim 20, the shorter bands as claimed are those bands between adjacent diamonds of adjacent serpentine bands; see Figure 2C.

Claims 9, 10, 13, 16, 17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmaz et al (US 5,102,417). Palmaz anticipates the claim language where the annular elements as claimed are met by the prostheses or grafts (70) of

Palmaz, and the connectors as claimed are the connectors (100) or spiral members (102) of Palmaz; see Figures 7 to 10 and column 11, line 35 et seq. The first or end prosthesis (70) (specifically the outer end of prosthesis (70)) of Palmaz inherently has less compression resistance because it lacks a connector (100) connected thereto. For this reason, it would be more easily compressed than the peaks with connectors connected thereto because it would not have the additional resistance caused by the connector.

With regard to claim 20, the shorter bands as claimed are the connecting members (77).

Claims 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Lau et al (US 5,514,154). Lau anticipates the claim language where the annular elements as claimed are the cylindrical elements (12) of Lau, the ends elements (12) inherently have less compression resistance than the intermediate elements (12) because they do not have interconnectors connected thereto as explained previously; see Figures 11 to 13 and note that the peaks of adjacent ends of cells are shown offset in Figures 11 and 12.

With regard to claim 18, Ni-Ti superelastic alloy, as disclosed by Lau, is equivalent to the definition of Nitinol as claimed; see the paragraph extending between columns 6 and 7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

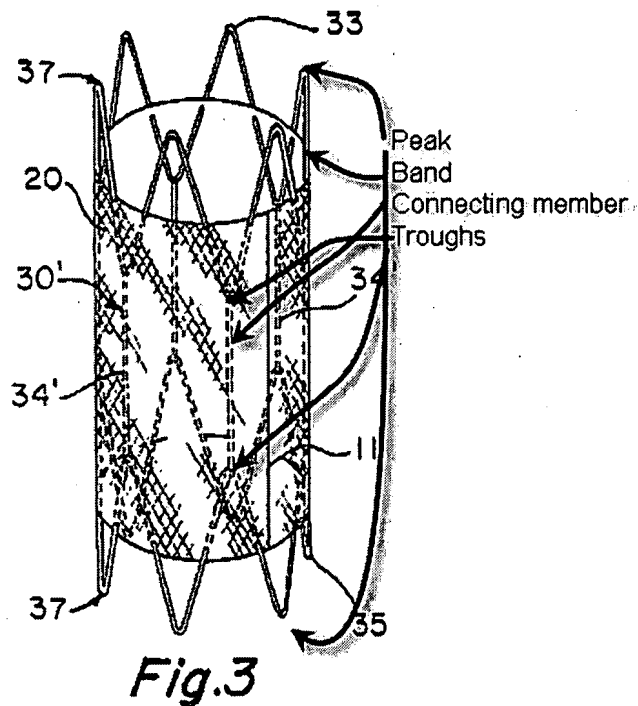
invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al (US 5,514,154) in view of Palmaz et al (US 5,102,417). Lau meets the claim language as explained supra but fails to disclose that the first end of the cell is offset circumferentially, with respect to the circumference of the tubular body, from the second end of the cell. However, Palmaz teaches that it was known to make connectors extend at an angle; see the previously cited portions of Palmaz supra. Therefore, it is the Examiner's position that it would have been obvious to make the connectors of Lau (either the Figure 11 or 12 embodiment) extend at an angle to offset the ends for the same reasons that Palmaz does the same.

#### ***Response to Arguments***

Applicant's arguments filed April 27, 2007 have been fully considered but they are not persuasive.

Applicants traverse the Robinson rejection by stating that it is not clear what elements of Robinson's device correspond to the bands, connecting members, peaks and troughs as claimed. The Examiner though and still thinks that these elements are clear based upon the rejection as stated currently and previously. However, in order to help the Applicants' understanding of the rejection, the following marked up drawing is provided below:



In response to the traversal of Pinchasik that Pinchasik does not include serpentine bands connecting by connecting members, the Examiner asserts that the serpentine bands are the whole segments (102) not just half of that structure as apparently understood by the Applicants. The whole segments (102) are serpentine to the extent that this language can be given patentable weight. Additionally, the connecting members as claimed are designated as links (112) in Pinchasik.

The traversal of the Palmaz rejections is similar to the traversal of Pinchasik so the previous paragraph is incorporated hereinto. The cells Palmaz are bounded by the connecting members (100) formed as spiral members (102).

With regard to the traversal of the Palmaz rejection that Palmaz does not have ends that are less compression resistant, the Examiner asserts that it is inherent that an additional connection to a point inherently has more resistance to movement as compared to a point with one less because of the additional force required to overcome the resistance presented by the additional connector. Even if the additional connector were much smaller or thinner than the other connectors, it would still increase the crush resistance by an amount corresponding to its size.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure

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outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3738